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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,289

08/31/2006

Harald Hager

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EXAMINER

LEONARD, MICHAEL L

ART UNIT

PAPER NUMBER

1763

MAIL DATE

DELIVERY MODE

11/01/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,289	Applicant(s) HAGER ET AL.	
	Examiner MICHAEL LEONARD	Art Unit 1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/13/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The current action contains the same grounds of rejection as previously set forth in the non-final office action (09/09/2009) and the final office action (03/03/2010) and therefore it is proper to make the current action FINAL.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0130381 to Joachimi et al. in view of U.S. Patent No. 5,830,568 to Kondo.

Regarding the claims, the ground of rejection has been previously set forth in paragraphs 6-10 of the non-final action mailed 9/9/2009 and is herein incorporated by reference.

Claims 61-75 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0130381 to Joachimi et al. in view of U.S. Patent No. 5,830,568 to Kondo and U.S. Patent Pub. No. 2004/0030384 to Wissman.

Regarding the claims, the ground of rejection has been previously set forth in paragraphs 12-19 of the non-final action mailed 9/9/2009 and is herein incorporated by reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 61-80 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 38-57 of copending Application No. 10/544,041.

The rejection has been previously set forth in paragraphs 5-7 of the final action mailed 4/2/2009 and is herein incorporated by reference.

Claims 61-80 are directed to an invention not patentably distinct from claims 38-57 of commonly assigned 10/544041, similar as noted above.

The rejection has been previously set forth in paragraphs 18-19 of the final rejection mailed 03/03/2010 and is herein incorporated by reference.

Response to Arguments

Applicant's arguments filed 07/13/2010 have been fully considered but they are not persuasive. Applicants argue that the claimed invention has not been rendered obvious by Joachimi ('381) in view of Kondo ('568) and Wissman ('384) for 2 reasons.

1) The first being that the combination of references does not relate to the unique combination concentration of particles and the particle size disclosed by the claims.

2) The second being that a person of ordinary skill in the art would not look to combine the teachings of Joachimi and Kondo in order to maintain transparency since Joachimi is primarily concerned with natural-colored and pigmented laser-absorbing molding compositions."

In response to issue 1), the applicants' have erred in regards to the references. The primary reference to Joachimi discloses component a), the plastic material and component b), the metal oxides in an preferred range of from 0.0004 to 0.05 weight percent, which lies inside of the claimed range and that includes metal oxide containing particles (0106). Therefore, the only thing missing from the primary reference is the size of the particles. With regards to this limitation, the Kondo reference was brought in to show that a preferred particle range of from 10 to 30 nanometers should be used (Column 3, line 18). Therefore, the combination of references renders the claims *prima facie* obvious, because the concentration and particle size are disclosed in the primary and secondary references, respectively.

The applicants' argued that obviousness under these circumstances should be governed by the principles set forth in *In re Baird* under 2144.08. This case relates to genus/species relationships. However, obviousness of ranges (issue at hand) falls under 2144.05 and does not relate to a genus/species relationship. The ranges taught by the combination of references to Joachimi and Kondo overlaps and actually lie within the claimed range in preferred embodiments of the references. It is well settled that where prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a *prima facie* case of obviousness is established. See MPEP 2144.05; *In re Harris*, 409, F.3d. 1339, 1343, 74, USPQ2d 1951, 1953 (Fed Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 3d 1379, 1382 (Fed. Cir 1997); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ

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549, 553 (CCPA 1974). In light of the cited patent case law, it would have been obvious that in this particular instance to use the amount of filler disclosed by Joachimi using the particle size disclosed by Kondo that falls within the claimed range.

In response to issue 2), the Joachimi reference discloses that the compositions contain at least one IR absorbing component, the Kondo reference discloses suitable IR absorbing components that fall within the scope of the claims and it would have been obvious to substitute one IR-absorbing component for another arrive at the presently claimed invention. Furthermore, while the molded parts of Joachimi are to be pigmented and/or colored and therefore will not be 100% transmissive, the transparency motivation gleaned from Kondo is still relevant since one of ordinary skill in the art would understand the importance of using an additive that does not change the calculated light absorptivity of the final composition. A user may intend on a certain transparency/color based on the desired pigment composition and if an IR absorptive particle (which both references contain) is used that changes these light properties, then the user would be motivated to reformulate the pigment package to compensate for the light characteristics of said IR absorptive particle.

The fact that the Kondo reference is not concerned with laser welding at all is irrelevant because Kondo discloses known IR-absorptive components and a person of ordinary skill in the art would use the IR-absorptive components disclosed by Kondo because Joachimi requires such components to be present in his composition and it is prima facie obvious to add a known ingredient to a known composition for its known function. *In re Lindner* 173 USPQ 356; *In re Dial et al* 140 USPQ 244.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL LEONARD** whose telephone number is (571)270-7450. The examiner can normally be reached on Mon-Fri 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1763

/MICHAEL LEONARD/
Examiner, Art Unit 1763